

Application of Simon Erani
Serial No. 09/922,233 filed 8/3/2001
Response of 1/17/2006 to Office Action of 7/15/2005

Remarks

Receipt is acknowledged of the Office Action of July 15, 2006. A Request for Continued Examination is included herewith. Reconsideration of the application and a three month extension of the time for response are hereby requested. The Commissioner is hereby authorized to charge Deposit Account No. 50-1604 for all fees required, and it is requested that any overpayments be credited thereto.

Counsel would like to thank the Examiner and her supervisor for the professionalism they exhibited to counsel and applicant in the recent interview. Further thereto, the present response is being filed to attempt to advance prosecution and to clarify the outstanding issues remaining with respect to the claims that stand rejected.

Previously, the Examiner had allowed pending claims 2, 7, 20, 25, and 34-37 (now 33-36).¹ The remaining claims were rejected over Brooks II and French Reference 2,746,008 in view of the assertion that the present invention would be obvious over the combined teachings of those references pursuant to 35 U.S.C. §103. Reconsideration of the rejections is respectfully requested.

As is well known, to establish a *prima facie* case of obviousness, three basic criteria must be met. "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally,

¹ Counsel notes that, further to the prior Office Action, previously misnumbered claims 31-41 have been renumbered 30-40 herein, as presented in the listing of claims set forth above.

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the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure". See, MPEP §2143 (Eighth Edition 2001; May 2004 Revision).

Accordingly, reconsideration of the rejections is requested on the grounds that there is insufficient basis in the record to establish, or to even evaluate, a *prima facie* case of obviousness under these three requirements, based on the art being relied upon. In particular, one of the primary references at issue, the '008 reference, is entirely in the French language. It is respectfully submitted that there is insufficient evidence to sustain a *prima facie* case, or, conversely, to properly traverse it, in view of the absence of any clarity as to exactly what the '008 reference does and does not teach. While the reference refers to "Ascorbosilane C", it is unclear exactly what the disclosure is regarding that substance.

As set forth in the Manual of Patent Examining Procedure with respect to reliance on foreign language documents in support of a rejection, consideration of the full text of a document will yield the fullest available set of facts upon which to determine patentability. See, MPEP §706.02 II (Eighth Ed., Rev. 2, May 2004, p.700-21). As also acknowledged therein, it can be true that the full text of a document will include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. §103 when the abstract of it alone appears to support the rejection. *Id.*

It is submitted that a similar principle applies here. Although the document identifies Ascorbosilane C, the context and scope of its teachings about that substance is entirely unclear in

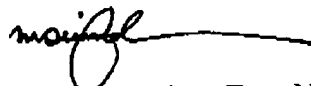
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view of the foreign language. Without a translation, it is submitted that a *prima facie* case has not, and can not be sustained. There is likewise insufficient evidence to allow applicant to meaningfully or adequately respond, in the absence of any showing or more complete demonstration as to the fuller context and teachings of the '008 reference, to determine what it does and does not teach and suggest.

Accordingly, it is respectfully requested that such a showing be made, e.g. such as with a translation of the document, or that the pending rejections be reconsidered and withdrawn.

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Respectfully submitted,



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